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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,454	12/12/2000	Koji Kuchiishi	33193	8594

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EXAMINER

CHIANG, JACK

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,454

Applicant(s)

KUCHIISHI ET AL.

Examiner

Jack Chiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,6,8-10 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 6, 8-10, 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) .
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

CLAIMS

Art Rejection

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Nevo et al. (US 5371790).

Regarding claim 4, Nevo shows a portable telephone unit (10) comprising:

Soft material (20-26) that protrudes more than hard material (32, 52) formed on surfaces of upper and lower cases formed of the hard material, a portion of a surface (see side walls adjacent to keypad) of the soft material is corrugated to facilitate shock absorption (col. 2, lines 20-24, col.3, lines 47-50, col. 4, lines 1-9).

Regarding claim 6, Otake shows:

The soft material (20-26) which covers a grip portion of upper and lower cases (32, 52).

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-10, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otake (JP 6-268548) in view of Bent et al. (US 5613237).

Regarding claim 8, Otake shows a portable telephone unit (10) comprising:

An upper case (12);

A lower case (22);

A waterproof rib (55) formed of soft material located on a periphery of one of the cases;

A waterproof groove (56) formed of the shock absorbing soft material located on a periphery of the other of the cases;

The waterproof rib and the waterproof groove (55, 56) are coupled together to facilitate a waterproof coupling between the cases (12, 22).

Otake differs from the claimed invention in that it does not explicitly show a portion of a surface of the soft material is corrugated.

However, Bent teaches providing a shock absorbing soft material having a portion which is corrugated (see 100).

Hence, it would have been obvious for one of ordinary skill in the art to modify Otake's soft material with a corrugated portion as taught by Bent, such that to improve the

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gripping of the device, and to provide a device that is simple and easy to assemble (col. 1, lines 30-32 in Bent).

Regarding claims 9-10, 13-14, the combination of Otake and Bent shows:

The waterproof groove (56 in Otake);

The fan-shaped waterproof rib (55);

The soft material (11, 21) which covers a grip portion of upper and lower cases (12, 22);

The upper and lower cases (phone cases 12, 22) are formed of a hard resin material;

The rib and the groove (55, 56) is formed integrally with the cases (12, 22, see figs 5 and 7).

Regarding claim 15, Otake shows a portable telephone unit (10) comprising:

A first case (12) having a first joint face;

A second case (22) having a second joint face;

A waterproof rib (55) formed of soft material located on a periphery of one of the cases;

A waterproof groove (56) formed of the shock absorbing soft material located on a periphery of the other of the cases;

The waterproof rib and the waterproof groove (55, 56) are coupled together to facilitate a waterproof coupling between the cases (12, 22).

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Otake differs from the claimed invention in that the second joint face is indirectly but not directly contacted to the first joint face when they are fitted;

However, Bent teaches providing a shock absorbing and waterproof soft material where the joint faces (see contact areas between 202 and 2004 in Bent's fig. 7) of the first and second casings are directly contacted when they are fitted;

Hence, it would have been obvious for one of ordinary skill in the art to modify Otake's casings with the latching as taught by Bent, such that not only to provide a latching between the waterproof latch but also to align and reinforce the latching of the two casings (col. 1, lines 56-63 in Bent).

Regarding claims 16-17, the combination of Otake and Bent shows:

A stepped portion (see fig. 5 in Bent) for supporting of the waterproof rib, this is considered as a variation of Otake as the concept of providing the rib is substantially in the same; and

The exposed joint faces (see direct contacts between the casings 202, 204 in Bent) while the waterproof ribs are provided.

ARGUMENT

5. In response to the remarks filed on 04-04-05, in page 5, applicant first argues that "Nevo et al. does not disclose a portable telephone unit comprising soft material

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formed on surface of upper and lower cases formed of a hard material, as recited in independent claim 4”.

Lets look at claim 4, it recites “a portable telephone unit comprising **soft material that protrudes more than hard material formed** on surface of upper and lower cases formed of the hard material ...”.

First, claim 4 is not the same as applicant argues about it in the remarks. In claim 4, it describes that the hard material formed on surface of upper and lower cases, and it just requires that the soft material **protrudes** more than the hard material. It is not the same as “soft material formed on surface of upper and lower cases” as applicant argues. Nevo meets the claimed limitation.

In page 5, applicant further argues that Nevo’s electromechanical unit 32 and a sub-housing 52 are not equivalent to the claimed upper and lower cases.

The examiner disagrees. Noted that “upper and lower cases” are recited in the claim, it is certain that almost all electronic units would have “upper and lower cases”, otherwise, it would show bare components on circuit boards. Further, even applicant pulls the term “sub-housing 52” from Nevo, this is the answer for applicant’s argument regarding the claimed term “upper and lower cases”.

In pages 6, in the combination of Nevo and Bent, applicant argues that the latch connection of Otake would have been modified, not the surface configuration of the soft material.

First, the examiner agrees with applicant that the Bent’s latch could be a teaching to Otake’s latch. Second, one of ordinary skill in the art would also recognize

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why Bent provides corrugations on the surface of the band, because it would provide a better grip for the band. In the manufacture point of view, it is properly easier to manufacture a "flat" surface than a "corrugated" surface, because the mold the less complicated. The reasons why Bent goes extra steps to create such "corrugated" surface is because it is understood that when the band is provided at the middle of the device as shown by Bent, that is the area where a user would most likely to hold the device, and such "corrugated" surface has a specific function for the device, otherwise, it could just be a "flat" surface.

In conclusion, the reasons for the 103 rejection have been well established, see rejections above.

6. Applicant's arguments with respect to claims 4, 6, 8-10, 13-17 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c) on 04/04/05 prompted the new ground(s) of rejection under 37 CFR 1.109(b) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.02(I)(3). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 571-272-7483. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jack Chiang
Primary Examiner
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